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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/632,003	07/30/2003	Scott F. Watson	038.P006	2312

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EXAMINER

MONTOYA, OSCHTA I

ART UNIT	PAPER NUMBER
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2421

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07/29/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/632,003

Applicant(s)

WATSON ET AL.

Examiner

Oshta Montoya

Art Unit

2421

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period **will** apply and **will** expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply **will**, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 April 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-47 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-47 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 04/08/2009 have been fully considered but they are not persuasive.
2. in the interview, on March 18, 2009, the examiner stated that the applicant's proposed amendments appear to overcome the art of record; however, after carefully reading the Rhoads reference, it still meets the limitations.
3. the claim language that "... the asset is stored on said user device after delivery of said asset is complete" is met as follows, Rhoads teaches that the user can press a capture button that will record the song being played and then download the song to the user location whenever is convenient, meaning that the asset will be stored at the user end after the user already listen to the song (col. 8, lines 15-45).
4. the limitation that the content is "real-time content", this is clearly disclosed by Rhoads, since Rhoads teaches that the system can work in real time (col. 15, lines 30-35).

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
6. Claims 26-42 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 26-42 are vague because although the preamble recites a system, the body of the claim recites an asset list, an asset, and a real time content stream that are all not structural elements. Rather, an asset list, an asset, and a real time content stream appear to be data only.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 1-47 are rejected under 35 U.S.C. 102(e) as being anticipated by Rhoads et al., US 6,442,285.

Regarding claim 1, Rhoads discloses a method for delivering an asset over a network for integration with a real-time content stream (Fig. 1 and col. 3/line 61 to col. 4/line 14 as the music is delivered over the internet to consumers) comprising:

supplying an asset list over said network to a user device(col. 25/line 50 to col. 26/line 7 as client process is a computer process of client computer connected to the user device; and an asset list is the list of available media or music delivered to the user for downloading, i.e., refer to col. 8/line 49 to col. 9/line 25 as the user has a memory

includes a data structure that serves as a look up table for searching and indexing music songs in the user's online music library, Col. 16, lines 10-50);

delivering an asset, which is included in said asset list, so that said asset is stored on said user device after delivery of said asset is complete, over said network to said user device if a predetermined constraint is satisfied (col. 8, line 15-50, col. 9/line 25 to col. 10/line 21 as an example for delivering of ordering music based on the user's constraint or authorization and/or based on some other constraints, see col. 13/lines 35-52); and

integrating the delivered asset with said real time content stream (col. 9, lines 4-45, col. 15, lines 30-35, Col. 20, lines 40-67).

Regarding claim 2, Rhoads discloses the method according to claim 1, wherein said asset comprises at least one of an audio content, a video content, a text content, a right to use license or a multimedia file (col. 8/line 49 to col. 9/line 25 for audio and text data; and col. 12/line 59 to col. 13/line 11 for video and games etc.).

Regarding claim 3, Rhoads discloses the method according to claim 1, further comprising, prior to said supplying said asset list, generating said asset list at least in part in response to a request from said user device (col. 8/line 49 to col. 9/line 25 as the user requests and downloads music over the internet to their own device and the device has a memory includes a data structure that serves as a look up table for searching and indexing music songs in the user's online music library, which suggests that the user

generates the asset list to the provider, Col. 16, lines 10-50)

Regarding claim 4, Rhoads discloses the method according to claim 1, wherein said real-time content stream is transmitted from a content web site (col. 9, lines 4-45, col. 15, lines 30-35, refer to col. 16/line 32 to col. 17/line 17 for an example of the user accesses a content web site using hypertext link or URL for downloading the content to the user's device or col. 23/lines 43-50 for another example, col. 16, lines 10-50).

Regarding claim 5, Rhoads discloses the method according to claim 1, wherein said predetermined constraint comprises at least one of said user device being idle, a network Quality of Service (QoS) of said network, or the bandwidth usage being below a predetermined operating level (col. 21/line 50 to col. 22/line 6 for QoS of content provider addressed).

Regarding claim 6, Rhoads discloses the method according to claim 1, wherein said predetermined constraint comprises at least one of said user device CPU usage, or memory usage in said user device being below predetermined operating levels (col. 13/lines 35-45 for quality issue of the user device addressed).

Regarding claim 7, Rhoads discloses the method according to claim 1, wherein the delivery of said asset, over said network to said user device includes delivering said asset in response to a request from said user device (col. 19/lines 15-40 as the content

is delivered from the server to the user device, i.e., a computer or set top box, or television, audio appliances etc. according to the user's request or pay-for-content, col. 16, lines 10-61).

Regarding claim 8, Rhoads discloses the method according to claim 1, wherein said delivered asset is stored as it is delivered (col. 8/lines 15-48 as the data can be stored in memory or hard disk at the user's residence).

Regarding claim 9, Rhoads discloses the method according to claim 8, and further comprising presenting the stored asset integrated with said real-time content stream in real time (col. 9, lines 4-45, col. 12/lines 47-58 for live events can also be recorded with a (hyper) link col. 15, lines 30-35).

Regarding claim 10, Rhoads discloses the method according to claim 1, wherein said predetermined constraint comprises at least in part a time of day (col. 9/lines 37-45 as the user can specify which time of the day to upload or update new content via the internet).

Regarding claim 11, Rhoads discloses the method according to claim 8, and further comprising determining said predetermined constraint from CPU usage of said user device, a-bandwidth usage, a-local cache usage, or a user device activity timer

(col. 13/lines 35-45 for quality issue of the user device addressed, col. 8/lines 38-48 as the data can be stored in memory or hard disk at the user's residence).

Regarding claim 12, Rhoads discloses the method according to claim 8, and further comprising presenting a substitute asset integrated with said real-time content stream, if said asset is unavailable at said user device (col. 12/line 47 to col. 13/line 12 for the user has more option to access to promo clips, so that the user has more choice to have alternative content or option if one is unavailable, col. 15, lines 30-35).

Regarding claims 13-25, these claims for "a method for presenting to a user a continuous and uninterrupted stream of content over the network, the method comprising: supplying an asset list over the network to a client process, said client process operating in a user device; delivering an asset, from a remote location, over the network to the user device if a predetermined constraint is satisfied, so that said asset is stored on said user device after delivery of said asset is complete, wherein the asset list comprises at least an indication of said remote location (user interaction or user's request, see col. 16/line 51 to col. 17/line 17); and integrating the delivered asset with a real-time content stream being received by the user device from the remote location over the network" are rejected for the reasons given in the scope of claims 1-12 with media streams of content delivered over the Internet to the remote user/client (col. 9, lines 4-45, col. 15, lines 30-35, col. 16, line 10-50, col. 25/line 25 to col. 26/line 56), not limited to the cited paragraphs above, but also to the entire disclosure of Rhodes.

As for claims 26-42, these claims for “a system for presenting content over a network, the system comprising: an asset list capable of being made available by a content provider over the Internet to a client process (col. 25/lines 25-61 for HTML, IP addresses of the Internet), said client process capable of operating in a user(’s device); an asset, capable of being made available from a remote location, over said network to said user device if a predetermined constraint is satisfied, so that said asset is stored on said user device after delivery of said asset is complete, wherein said asset list comprises at least an indication of said remote location and a real-time content stream capable of being made available to said user device from said remote location over said network and capable of being integrated with said asset ” are rejected for the reasons given in the scope of claims 1-12 with media streams of content delivered over the Internet to the remote client/user (col. 9, lines 4-45, col. 15, lines 30-35, col. 16, line 10-50, col. 25/line 25 to col. 26/line 56), not limited to the cited paragraphs above, but also to the entire disclosure of Rhodes.

Regarding claim 43, Rhodes discloses “a method for presenting a stream of content over a network, the method comprising: supplying an asset list by a content provider over said network to a client process, said client process operating on a user device; delivering an asset, from a remote location, over said network to said user device if a predetermined constraint is satisfied, so that said asset is stored on said user device after delivery of said asset is complete, wherein said asset list comprises at least

an indication of said remote location; and integrating the delivered asset with a real-time content stream being received by said user device from said remote location over the network; wherein said stored asset and said real-time content stream are represented” (refer to claims 13-25 as noted above).

Regarding claim 44, Rhodes discloses “a system for receiving an asset over a network, the system comprising: an asset list to be made available by a content provider over said network to a client process, said client process operating in a user device; an asset, to be made available from a remote location, over said network to said user device if a predetermined constraint is satisfied, so that said asset is stored on said user device after delivery of said asset is complete, wherein said asset list comprises at least an indication of said remote location; and an integrator tool for integrating the stored asset with a real-time content stream being received by the user device from the remote location over said network, wherein said predetermined constraint includes at least one of said user device being idle, the bandwidth usage being below a predetermined operating level, the time of day, the user device CPU usage, or memory usage being below predetermined operating levels” are rejected for the reasons given in the scope of claims 1-12 with media streams of content delivered over the Internet to the remote client/user (col. 25/line 25 to col. 26/line 56) not limited to the cited paragraphs above, but also to the entire disclosure of Rhodes.

As for claim 45, Rhodes discloses a method for receiving an asset over a network (Fig. 1 and col. 3/line 61 to col. 4/line 14 as the music is delivered over the internet to consumers), comprising: delivering an asset list provide by a content provider over said network at a client (col. 25/line 50 to col. 26/line 7 as client process is a computer process of client computer connected to the user device; and an asset list is the list of available media or music delivered to the user for downloading, i.e., refer to col. 8/line 49 to col. 9/line 25 as the user has a memory includes a data structure that serves as a look up table for searching and indexing music songs in the user's online music library); said client operating in a user device; and receiving said asset, corresponding to at least a portion of said asset list, over said network at user device if a predetermined constraint is satisfied, so that said asset is stored on said user device after delivery of said asset is complete (col. 9/line 45 to col. 10/line 21 as an example for delivering of ordering music based on the user's constraint or authorization and/or based on some other constraints, see col. 13/lines 35-52); wherein said predetermined constraint is at least one of said user device being idle, the network Quality of Service (QoS), the network bandwidth usage being below a predetermined operating level, the user device CPU usage, or memory usage of said user device being below operating levels (col. 21/line 50 to col. 22/line 6 for QoS of content provider addressed; and col. 13/lines 35-45 for quality issue of the user device addressed); and receiving a real-time content stream wherein said stored asset and said real-time content stream are to be integrated (col. 9, lines 4-45, col. 15, lines 30-35, col. 16, line 10 to col. 20 line

67) not limited to the cited paragraphs above, but also to the entire disclosure of Rhodes.

As for claim 46, Rhodes discloses “a method for providing a home media library to a user over a network, the method comprising: supplying an asset list by a content provider over the network to a set-top box, the set-top box including a client process which manages the delivery of assets; and delivering an asset, from a remote location, over the network to the set-top box if a predetermined constraint is satisfied, so that said asset is stored on said user device after delivery of said asset is complete, as indicated by said client process wherein said asset list comprises at least an indication of said remote location” (refer to claims 1 and 13 with a set top box is included as one of the user devices, col. 19/lines 30-40); and delivering a real-time content stream, wherein said stored asset and real-time content stream are to be integrated (col. 9, lines 4-45, col. 15, lines 30-35, Col. 16, line 10 to col. 20 line 67) not limited to the cited paragraphs above, but also to the entire disclosure of Rhodes.

As for claim 47, Rhodes teaches a method of receiving media assets (Fig. 1 and col. 3/line 61 to col. 4/line 14 as the music is delivered over the internet to consumers) at a set-top box for storage and subsequent viewing (with a set top box is included as one of the user devices, col. 19/lines 31-40), the method comprising the steps of:

receiving a media asset list from a content provider on said set top box, said media asset list comprising a list of media assets to be downloaded and information about the location of each of the media assets; running a client process on said set top box, wherein said client process is capable of reading said media asset list to determine what media assets to transfer to the set top box and wherein said client process is further capable of managing delivery of digital media assets based at least in part on predetermined constraints (See col. 23/ lines 51-65 for the address location, and col. 25/line 50 to col. 26/line 7 as client process is a computer process of client computer connected to the user device; and an asset list is the list of available media or music delivered to the user for downloading, i.e., refer to col. 8/line 49 to col. 9/line 25 as the user has a memory includes a data structure that serves as a look up table for searching and indexing music songs in the user's online music library); downloading digital media assets from said content provider to said set top box if the predetermined constraints are satisfied; and storing the downloaded digital media assets on the set top box; (col. 8/line 38- 64 for user home music library which downloading music online or over the Internet; and col. 9/line 45 to col. 10/line 21 as an example for delivering of ordering music based on the user's constraint or authorization and/or based on some other constraints, see col. 13/lines 35-52); and integrating the stored assets with a real-time content stream for viewing on a television or other display device (col. 9, lines 4-45, col. 15, lines 30-35, Col. 16, line 10 to col. 20 line 67) not limited to the cited paragraphs above, but also to the entire disclosure of Rhodes.

Contact

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Oshta Montoya whose telephone number is (571)270-1192. The examiner can normally be reached on Monday/Friday 8:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W. Miller/
Supervisory Patent Examiner, Art Unit 2421

OM